

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Thierry DUVERGER et al.**

Group Art Unit: **3747**

U.S. Appl. No.: **10/551,826**

Confirmation No.: **3979**

Filed: **June 26, 2007**

Examiner: **Keith A. Coleman**

For: **SELF-IGNITING PETROL INTERNAL COMBUSTION ENGINE**

Attorney Docket Number: **PSA0304231**

Customer Number: **38834**

PETITION UNDER 37 C.F.R. 1.181
FOR WITHDRAWAL OF FINALITY
OF OFFICE ACTION dated March 12, 2009
AND
FOR NEW, NON FINAL OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 12, 2009

Sir:

Applicants petition the Commissioner under 37 C.F.R. 1.181 for withdrawal of the final Office Action dated March 12, 2009 and for mailing of a new non-final Office Action, so that Applicants may be given a fair opportunity to address the rejections made in this Office Action. See 37 C.F.R. 1.104 and 1.111-1.113 and MPEP 706.07, 707.07 and 2145.

I. Summary of Actions and Submissions since the RCE of July 29, 2008

On July 29, 2008, Applicants responded to the final Office Action dated February 29, 2008 by filing an RCE with an Amendment presenting arguments in response to the art rejections and adding a new claim 13. The RCE was accompanied with a request for a three-month suspension.

The Examiner mailed a non-final Office Action on August 20, 2008. This Action was withdrawn in a Suspension letter dated September 22, 2008.

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On November 4, 2008, Applicants filed a Supplemental Response submitting a Declaration under Rule 1.132 regarding U.S. Patent No. 4,467,757 to Dazzi cited in a rejection by the Examiner in the Office Action dated February 29, 2008, and a certified partial English translation of the PCT application whose US national stage resulted in U.S. Patent No. 5,960,627 to Krampe et al. The Dazzi and Krampe references had been cited by the Examiner in the Office Action dated February 29, 2008.

On March 12, 2009, the Examiner mailed a first, final Office Action, which prompted this petition.

II. The Office Action is Deficient Because the Examiner has not Considered the Submission of July 29, 2008 and the Evidence Submitted on November 4, 2008

In the Office Action dated March 12, 2009, the rejections are substantially identical to the rejections in the Office Action dated February 29, 2008, except that the header on page 3 lists claim 13 and a “Response to Arguments” section is added on pages 7-8.

Even though the Examiner states on page 7 that “Applicant’s arguments filed 11/4/2008 have been fully considered but they are not persuasive,” the Examiner does not mention or acknowledge either (i) the Submission of July 29, 2008 or (ii) the Declaration and certified partial translation submitted on November 4, 2008.

MPEP 2145 states: “Office personnel should consider all rebuttal arguments and evidence presented by applicants” (emphasis added). Also in MPEP 2145: “Consideration of rebuttal evidence and arguments requires Office personnel to weigh the proffered evidence and arguments. Office personnel should avoid giving evidence no weight, except in rare circumstances.”

Here, the Examiner has given no indication that he considered the Submission of July 29, 2008.

Further, the Examiner has given no indication that he considered the evidence submitted November 4, 2008, let alone weighing the evidence, or possibly making the required determination of which “rare circumstance” that might have allowed him to avoid giving the evidence any weight.

Even if, arguendo, the expression “Applicant’s argument” as used by the Examiner on page 7 of the Office Action dated March 12, 2009 were interpreted to include consideration of the factual evidence submitted on November 4, 2008 (Applicants deny this interpretation, because the Office Action gives no hint that the Examiner has looked at either the Declaration or the translation), then consideration of “Applicant’s argument” should have included consideration of the factual evidence submitted on November 4, 2008.

MPEP 707.07(f) states: “In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application” (emphasis added). Also stated in MPEP 707.07(f): “Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it” (emphasis added).

Here, the factual evidence submitted on November 4, 2008 is clearly substantial to Applicants’ response of July 29, 2008 and supplemental response of November 4, 2008, and this is clearly articulated in, and in any case immediately derived from, the Remarks in both

Submissions. Therefore, because of the Examiner's silence as to both (i) the Submission of July 29, 2008 and (ii) the weight of the evidence submitted on November 4, 2008, or even as to whether he has considered this evidence at all, Applicants have not been granted a fair consideration of their argument and evidence.

In particular, it would be of import to the application record to indicate (i) whether the Examiner considered the Declaration but discounted it, and in this case, why, (ii), whether the Examiner considered the translation but discounted it, and in this case, why, or (iii) whether the Examiner has not considered the evidence submitted by the Applicants, and in this case, why.

On the contrary, the Examiner has now mentioned another document U.S. Patent Application Publication No. 20030019466 to Walter et al., without citing it in a rejection. Not knowing whether or how the Examiner has weighed the evidence submitted previously to address the Dazzi and Krampe references, and faced with a first, final Office Action mentioning Walter, Applicants cannot fairly determine how to address the Examiner's position relative to Walter. Thus, Applicants have not been given a fair opportunity to understand and address the Examiner's rejections in this Office Action.

III. The Finality of the Office Action Dated March 12, 2009 is not Justified, Especially Since the Withdrawn Office Action Dated August 20, 2008 was non-Final

The Examiner erroneously mailed an Office Action on August 20, 2008, presumably by omitting to take into account the 3-month suspension requested with the RCE of July 29, 2008. At that time, the Examiner made the Action (a first Action after the RCE) non-final. The Office Action dated August 20, 2008 was subsequently withdrawn on September 22, 2008. Subsequently,

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Applicants filed a Supplemental submission on November 4, 2008 with factual evidence (declaration and translation).

It is illogical, and indeed, arbitrary and capricious, and an abuse of discretion, that the Examiner would mail a replacement Office Action dated March 12, 2009 in the form of a final Action, when it addresses similar amendment and arguments as the withdrawn Office Action dated August 20, 2008, further supplemented by the supplemental submission and factual evidence of November 4, 2008.

In addition, it is submitted that the requirements for a first, final Office Action are not met, at least because the Examiner has not determined that new claim 13 could have been finally rejected in the earlier application. See MPEP 706.07(h) and MPEP 706.07(b).

It is noted that, in the Office Action dated March 12, 2009, (i) the Examiner mentions the submission of November 4, 2008 but not the submission of July 29, 2008 (whereas the erroneous and withdrawn Action of August 20, 2008 did refer to the Submission of July 29, 2008) and not the evidence submitted on November 4, 2008, and (ii) the Examiner has not used the form paragraphs for a first Action final after an RCE, as set forth in MPEP 706.07(h). Namely, it appears that the Examiner simply did not take into account - or erroneously appreciated - the status of this application. Accordingly, the Examiner has not established a ground for making the Office Action dated March 12, 2009 a final Action.

Here also, because of these defects and omissions in the Office Action dated March 12, 2009, Applicants are being denied a fair opportunity to understand and address the rejections in this Office Action.

Conclusion

In summary, it is submitted that the Office Action does not comply with the requirements that the submission of July 29, 2008 and the factual evidence submitted on November 4, 2008 should have been considered, and that a clear explanation (even if succinct) should have been provided (MPEP 707.07 and MPEP 2145).

Also, it is submitted that the Office Action does not comply with the requirements that the finality of this first Office Action after an RCE should have been justified, especially in view of the fact that the previous, withdrawn Office Action addressing similar issues was non-final (MPEP 706.07).

As stated in MPEP 706: “The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. The examiner then reviews all the evidence, including arguments and evidence responsive to any rejection, before issuing the next Office action” (emphasis added).

Here, not only the Examiner does not give any indication in the Office Action that he has looked at the evidence submitted by the Applicants, but in making his first Action final, the Examiner has not justified his decision and has denied the Applicants a fair opportunity to respond. Therefore, it is submitted that the Examiner’s action in the Office Action dated March 12, 2009, including its finality, are “arbitrary, capricious, and an abuse of discretion, or otherwise not in accordance with the law.” 5 U.S.C. 706(2)(A).

In view of the above, it is requested that the final Office Action dated March 12, 2009 be

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withdrawn and a new, non-final Office Action be mailed, so that the Examiner may explain clearly whether the Submission of July 29, 2008 has been considered, whether the evidence submitted in the Supplemental submission of November 4, 2008 has been considered, and if so, how it has been considered, or why it has not been considered.

Also, it is requested that the finality of the Office Action be withdrawn.

If any fees are due in connection with this paper, please charge our Deposit Account No. 502759.

Respectfully submitted,

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